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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/051,338

01/18/2002

Lou Chauvin

83304CF-P

9961

7590

07/28/2006

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/051,338	CHAUVIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert M. Pond	3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-10 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

All pending claims (1, 4-10, and 13-19) were examined in this non-final office action necessitated by new grounds of rejection.

### ***Response to Arguments***

#### **Pertaining to Rejection under 35 USC 103 in previous office action**

Applicant's arguments with respect to claims 1, 4-10, and 13-19 have been considered but are moot in view of the new ground(s) of rejection.

#### **Pertaining to claims 4/13 and 8/17**

These claims remain overly broad. The Examiner is suggesting to the Applicant to consider additional subject matter that would distinguish over the prior art PhotoChannel cited below. The Applicant's specification discloses blocking information belonging to a retailer or entity who competes against the retailer whose photo kiosk is being used by the consumer. The Examiner is suggesting to the Applicant to consider a telephone interview for further discussion.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to

prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 1. Claims 1, 10, and 19 are provisionally rejected on the ground of nonstatutory double patenting over claims 1 and 20 of copending Application No. 09/939,369. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: online photo service associating service providers and business entities.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- 2. Claims 1, 10, and 19 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 20, 21, and 22 of copending Application No. 09/944,549. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the

instant application are claiming common subject matter, as follows: online photo service associating service providers and business entities.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

**3. Claims 1, 10, and 19 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 10, and 21 of copending Application No. 010/050, 979. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: online photo service associating service providers and business entities.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

- 4. Claims 1, 10, and 19 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 10, and 19 of copending Application No. 10/051,340. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: online photo service associating service providers and business entities.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 4-10, and 13-19 are rejected under 35 USC 103(a) as being unpatentable over PhotoChannel (a collection of prior art cited in PTO-892, Items: U-W that provides a composite disclosure of PhotoChannel's online business methods and systems).**

PhotoChannel teaches a system and method of online shopping for cameras, accessories and supplies, photo sharing, and providing photo print services for film and digital photography enthusiasts available at [www.photochannel.com](http://www.photochannel.com) (U: see at least page 3; V: see at least page 2). PhotoChannel teaches PhotoChannel offering lifetime archiving and online editing of pictures for home or office computer users and network members, print order origination including home or office computer users, various portals and online communities featuring photo sharing as well as traditional brick and mortar retailers (U: see at least page 2). PhotoChannel teaches PhotoChannel's open, global digital imaging network that provides a secure private network to link digital minilabs and digital photo kiosks worldwide to consumers, retailers, online portals, and online



communities with photo sharing features (U: see page 2). PhotoChannel further teaches:

- Maintaining a registry of a plurality of photo service providers and business entities on a server, associating a selection of offerings of goods and services with respect to each of said plurality of photo service providers; Inherent in PhotoChannel are the structures necessary to permit the maintaining of a registry of a plurality of photo service providers and business entities on a server. For example, PhotoChannel discloses secure virtual private network communications (VPN) between network member locations and connecting in a hub and spoke VPN configurations, and further discloses www.photochannel.com as the web site maintained by a web sever (U: see pages 2 and 3). See maintaining a list of service providers and business entities pertaining to claim 4 below.
- Providing a plurality of order terminals...communicating over a communication network with said server; open, global digital imaging network that provides a secure private network to link digital minilabs and digital photo kiosks worldwide to consumers, retailers, online portals, and online communities with photo sharing features (U: see page 2).
- Maintaining information on said server with respect to business relationships between said plurality of photo service providers and said plurality of business entities; Inherent in PhotoChannel are the structures necessary to permit maintaining information on said server with respect to

business relationships between said plurality of photo service providers and said plurality of business entities. For example, PhotoChannel distinguishes users of the network as customers, business partners, and suppliers (U: see page2). PhotoChannel discloses wolfexpress.com becoming a member of the PhotoChannel network to provide photo print services for customers and other members of the PhotoChannel Network (V: see page 2). It would have been obvious to one of ordinary skill in the art at time of the invention to ascertain competitive relationships between photo service providers and business entities participating as members of the PhotoChannel Network based on the type of information maintained about each member's goods and/or services provided.

- Providing an offering for a desired good or service from two or more of said plurality of service providers from said server at one of said server, and selecting the desired good or service by a user of said order terminal.

Inherent in PhotoChannel are the structures necessary to permit offering and selecting desired good or service by user. For example, PhotoChannel provides online shopping and offering cameras, accessories and supplies from a plurality of members (V: see at least page 2).

- Pertaining to claim 4, wherein said offering is displayed in a presentation format that is also based on said business relationship; members of the Photographic Research Organization, a cooperative group of North

America's leading independent photo specialty retailers representing over 400 store front locations, have their own branded, unique photo sites, and are listed by PhotoChannel as print fulfillment members (W: see at least page 2). Please note: PhotoChannel is maintaining a list (i.e. a registry).

- Pertaining to claim 8, wherein said business relationships include friendly, neutral, and hostile relationships. Inherent in PhotoChannel are relationships between service providers and business entities that are based on partnerships, competitive, and non-competitive relationships. For example, PhotoChannel discloses maintaining a registry of members of a cooperative (i.e. friendly) but compete in the open market against each other (i.e. hostile).
- System: web server, communication over the Internet, VPN, remotely connected home and office computers, digital photo kiosks in retail
- locations: (U: see at least page 2; V: see at least page 2; W: see at least page 2). Inherent in PhotoChannel are the structures necessary to permit execution of computer software from computer readable medium. For example, a computer acting as a web server is executing software necessary to provide the functionality as disclosed by PhotoChannel.

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Pertaining to system claims 10, 13-16, and 18

Rejection of claims 10, 13-16, and 18 is based on the same rationale as noted above.

Pertaining to claim 19

Rejection of claim 19 is based on the same rationale as noted above.

### ***Conclusion***

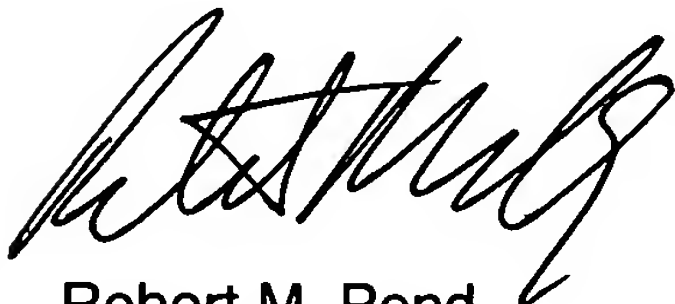
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- PhotoChannel: "PhotoChannel Networks Inc. to power online photo store for HotJobs.com's new college channel," Canada Newswire, 18 December 2000, Proquest # 65261802, 3pgs; teaches additional features of the PhotoChannel Network.
- PhotoChannel: "PhotoChannel announces international delivery of prints to over 200 countries," Canada Newswire, 11 December 2000, Proquest # 65094914, 3pgs; teaches additional features of the PhotoChannel Network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond  
Primary Examiner  
July 22, 2006